

## REMARKS

This communication is in response to the Office Action issued May 6, 2004 and the Examiner Interview of September 1, 2004. The Examiner objected to claim 11 as containing informalities. The Examiner rejected claims 2, 4, 6, 8-10, 20, 23, 25, 33, and 35-37 under 35 U.S.C. § 102 in view of U.S. Patent No. 5,726,984 to Kubler *et al.* (Kubler). The Examiner rejected claims 1, 3, 7, 11-19, 21, 24, 26-31, 34, and 38 under 35 U.S.C. § 103 in view of Kubler modified by one or more of U.S. Patent Nos. 5,742,596 to Baratz *et al.* (Baratz), 6,671,272 to Vaziri *et al.* (Vaziri), and 5,978,469 to Benson (Benson).

### Interview

The Applicant thanks the Examiner for conducting a personal interview on September 1, 2004. During the interview, the Examiner and the Applicant agreed that the rejections of claims 1 and the claims dependent thereupon were withdrawn. Furthermore, the Examiner and the Applicant agreed that if claim 11 were amended to incorporate the recitations of claim 13, the rejections of claim 11 and the claims dependent thereupon would be withdrawn. Claim 11 has been amended as discussed. Thus, the rejections of claim 11 and the claims dependent thereupon are withdrawn.

### Claim Objections

In section 1 of the Office Action, the Examiner objected to claim 11 as containing an informality. Specifically, the Examiner stated that “and” in line 9 should be replaced with -- or --.

Claim 11 has been amended above as suggested by the Examiner. In view of the foregoing, the Examiner’s objections to the claims are believed to be overcome.

Claim Rejections Under 35 U.S.C. § 102

In sections 2-3 of the Office Action, the Examiner rejected claims 2, 4, 6, 8-10, 20, 23, 25, 33, and 35-37 under 35 U.S.C. § 102 in view of Kubler.

It is well settled that for a rejection of a claim under 35 U.S.C. § 102 to be proper, each and every element as set forth in the claim must be found in a single reference. See, for example, MPEP § 2131. For at least the reasons stated below, the Examiner's rejections of the claims do not satisfy this burden.

It is initially noted that the Examiner attempts to reject several dependent claims without addressing the independent claims from which they depend. These claims are 2, 4, 10, and 20. This failure to address the independent claims makes these rejections improper. Therefore, the rejections of claims 2, 4, 10, and 20 must be withdrawn.

Further regarding claim 10, the Examiner introduced the Vaziri reference. Such use of two references is improper in an anticipation rejection. It is also noted that the rejection does not satisfy the requirements for a *prima facie* obviousness rejection.

Regarding claim 33 (and dependent claims 35-37), and as discussed during the September 1 interview, Kubler does not disclose the routing of an outgoing call. Furthermore, the Examiner does not address the "consisting essentially of" transitional phrase. The rejection is further improper since the Kubler system requires several pieces of equipment.

Regarding claims 6, 8, 9, 23, and 25, and as discussed during the September 1 interview, Kubler does not disclose the connection to a telephone in a user's home or the intelligent routing of calls to either a telephone line or a packet network

In view of the foregoing, the Examiner's rejections under 35 U.S.C. § 102 to the claims are believed to be overcome.

Claim Rejections Under 35 U.S.C. § 103

In sections 4-6 of the Office Action, the Examiner rejected claims 1, 3, 7, 11-19, 21, 24, 26-31, 34, and 38 under 35 U.S.C. § 103 in view of Kubler modified by one or more of Baratz, Vaziri, and Benson.

It is well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, each and every recitation of the claim must be present in the cited reference(s). See, for example, MPEP § 2143.03. It is also well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, there must be some suggestion or motivation to modify a reference or combine reference teachings. See, for example, MPEP § 2143.01. When so modifying a reference, the proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. See, for example, MPEP § 2143.01. The modification must support a reasonable expectation of success with some degree of predictability. See, for example, MPEP § 2143.02. Finally, the source of the suggestion or motivation to modify a reference cannot be the Applicant's own disclosure. See, for example, MPEP § 2143. For at least the reasons stated below, the Examiner's rejections of the claims do not satisfy these burdens.

Regarding claims 1 and 11 and the claims dependent thereupon, the rejections are withdrawn pursuant to the September 1 interview. Further regarding claim 18, the Examiner provides no motivation for the introduction of Vaziri encoder/decoder.

Regarding claim 26 and the claims dependent thereupon, the Applicant traverses the Examiner's rejection. Specifically, the Applicant traverses the Examiner's proffered motivation to modify the Kubler reference. The Examiner stated that "it would have been obvious to a person of ordinary skill in the art to employ the LAN interface as taught by Baratz in Kubler's

system to provide communication between two or more devices operating within near proximity, such as within a building or office.” Since the Baratz already provides this intra-premises communication, the introduction of the LAN interface of Kubler is unnecessary and, therefore, would not be an obvious modification to the Kubler system.

Regarding claim 19 and the claims dependent thereupon, the Applicant traverses the Examiner’s rejections for the same reasons as claims 1 and 11 and as discussed during the September 1 interview.

Regarding claim 34, the claim is allowable for at least the same reasons as claim 33, from which it depends.

The Applicant also traverses all rejections based in part on the Vaziri and Benson references. Regarding Vaziri, and as discussed in the September 1 interview, the Examiner has not established that the reference predates the instant application. Regarding Benson, the reference simply discloses a switch, not a control system with intelligent routing.

In view of the foregoing, the Examiner’s rejections under 35 U.S.C. § 103 to the claims are believed to be overcome.

#### Additional Fees

The Commissioner is hereby authorized to charge any insufficiency or credit any overpayment associated with this application to Swidler Berlin Shereff Friedman, LLP Deposit Account No. 19-5127 (order no. 20014.0002).

Conclusion

Claims 1-4, 6-12, 14-21, 23-31, and 33-38 are pending in the application, and are believed to be in condition for allowance. In view of the foregoing, all of the Examiner's rejections of the claims are believed to be overcome. The Applicant respectfully requests reconsideration and issuance of a Notice of Allowance for all claims. Should the Examiner feel further communication would help prosecution, the Examiner is urged to call the undersigned at the telephone number provided below.

Respectfully Submitted,



Sean P. O'Hanlon  
Reg. No. 47,252

Dated: September 2, 2004

Swidler Berlin Shereff Friedman, LLP  
3000 K Street, NW  
Suite 300  
Washington, DC 20007  
(202) 295-8429